UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,537	10/16/2003	Hyun-kwon Chung	1793.1075	4036

49455 7590 11/15/2007

STEIN, MCEWEN & BUI, LLP
1400 EYE STREET, NW
SUITE 300
WASHINGTON, DC 20005

EXAMINER	
PRICE, NATHAN E	

ART UNIT	PAPER NUMBER
2194	

MAIL DATE	DELIVERY MODE
11/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/686,537	CHUNG ET AL.	
	Examiner	Art Unit	
	Nathan Price	2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 September 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 October 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to communications received 05 September 2007. Claims 1 – 9 are pending. Previous objections and rejections not included in this Office Action are withdrawn.

Response to Arguments

2. With respect to the drawing objections, Figures 1, 2 and 12 fail to conform to 37 CFR 1.84(p)(1) and 37 CFR 1.84(q) at least because reference characters are encircled and not oriented in the same direction as the view (From 37 CFR 1.84(p)(1)) and "Lead lines are required for each reference character except for those which indicate the surface or cross section on which they are placed. Such a reference character must be underlined to make it clear that a lead line has not been left out by mistake." (From 37 CFR 1.84(q)). Figures 2 and 12 fail to conform to 37 CFR 1.84(p)(3) at least because reference characters cross lines.

3. Applicant's arguments regarding rejections under 35 U.S.C. 101 have been fully considered but they are not persuasive. The computer-readable medium appears to store only nonfunctional descriptive material. The markup document appears to be used when reproducing the AV data, but does not appear to provide reproduction functionality. For example, Figure 6 shows that the markup document is read and the markup document defines display information, but it does not provide reproduction

functionality. The control information of claim 1 is not required to include functionality recited in the dependent claims. It appears that nonfunctional descriptive material (information identifying the buffering state) satisfies the limitation.

4. Applicant's arguments regarding rejections under 35 U.S.C. 103(a) have been fully considered but they are not persuasive.

5. With respect to the claimed markup document, Landsman teaches supplying advertisements as HTML files [col. 5 lines 53 – 55; col. 7 line 29; col. 9 line 24]. Landsman teaches a different way of delivering and presenting the advertisements than the identified prior art, but it appears that HTML is an obvious format to use. Landsman teaches against embedding advertisement files in web pages [col. 9 line 23 – 24], not against supplying advertisements as HTML files. Landsman does teach that advertisement files can be JavaScript files [col. 11 line 46 – 65]. Applicant's own specification identifies JavaScript as an appropriate type of markup document [¶ 73]. Additionally, Goodman [see PTO-892 with this Office Action] teaches JavaScript files are markup documents [p. 17 ¶ 3].

6. With respect to the claimed interactive mode, Landsman teaches the advertisements are presented based on a user's actions [col. 10 lines 17 – 20]. The recited interactive mode is being examined based on its broadest reasonable interpretation. See definition of "interactive" in dictionary cited on PTO-892 with this

Office Action. Therefore, advertisements presented based on a user's actions teaches the claimed interactive mode. The Office Action mailed 05 June 2007 addressed this interpretation of interactive mode [#7].

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., defining "interactive" based on specific types of user control over reproduced content (p. 23 of REMARKS)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. With respect to the claimed control information, Landsman teaches the advertisements are presented in response to a trigger if the files are fully cached (state is fully cached) [col. 26 lines 43 – 49; col. 35 lines 11 – 12]. Landsman also teaches providing information about downloading operations [col. 35 lines 3 – 6]. The files must be downloaded and fully cached before they can be played and the API provides control information regarding these operations. Silberschatz provides additional information regarding signaling the status of a buffer.

9. With respect to the API of claim 3, Landsman teaches the advertisements are presented in response to a trigger if the files are fully cached (state is fully cached) [col.

26 lines 43 – 49; col. 35 lines 11 – 12]. Landsman also teaches providing information about downloading operations [col. 35 lines 3 – 6]. The files must be downloaded and fully cached before they can be played and the API provides control information regarding these operations. Regarding the parameters, Landsman teaches identifying advertisements by file name (attribute) and web address [col. 12 lines 24 – 26]. Therefore, the claimed API is obvious to one of ordinary skill in the art in view of the cited references.

10. Regarding new claims 8 and 9, see the current rejections.

Drawings

11. The drawings are objected to because Figures 1, 2 and 12 fail to conform to 37 CFR 1.84(p)(1) and 37 CFR 1.84(q) and Figures 2 and 12 fail to conform to 37 CFR 1.84(p)(3). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 1 – 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

13. The computer-readable medium of claim 1 appears to store only nonfunctional descriptive material. See MPEP 2106.01.

14. Claims 1 – 9 are directed to a signal directly or indirectly by claiming a medium and the Specification (¶ 95) recites evidence where the computer readable medium is defined as a "wave" (such as a carrier wave). In that event, the claims are directed to a form of energy, which at present the office feels does not fall into a category of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Sullivan (see Sullivan et al. on PTO-892 with this Office Action).

16. As to claim 1, Sullivan teaches a computer-readable medium having recorded thereon:

AV data [p. 75 ¶ 1];

a markup document which is provided to reproduce the AV data in an interactive mode [p. 75 ¶ 1 – 2; p. 78 ¶ 1 – 3]; and

control information which is provided to identify buffering state information of the markup document to be preloaded [p. 75 ¶ 1 – 2; p. 78 ¶ 1 – 3; p. 95 ¶ 1 – p. 96 ¶ 4; p. 97 last ¶; p. 177 last ¶; p. 33 ¶ 2; p. 45 ¶ 2].

17. As to claim 8, Sullivan teaches the AV data is AV data that was selected by a user to be viewed by the user while being reproduced in the interactive mode [p. 78 ¶ 2 – 3; p. 79 ¶ 1 – 3; Fig. 9.2].

18. As to claim 9, Sullivan teaches the interactive mode is an interactive mode that was selected by a user who will view the AV data in the interactive mode [p. 78 ¶ 2 – 3; p. 79 ¶ 1 – 3; Fig. 9.2].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19. Claims 1 – 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al. (US 6,466,967 B2; hereinafter Landsman) in view of Silberschatz (Silberschatz, Avi, Peter Galvin and Greg Gagne, "Applied Operating System Concepts," First Edition, John Wiley & Sons, Inc., 2000.).

20. As to claim 1, Landsman teaches a computer-readable medium having recorded thereon:

AV data [col. 25 lines 33 – 38; col. 26 lines 1 – 15];

a markup document which is provided to reproduce the AV data in an interactive mode [col. 9 lines 23 – 55; col. 10 lines 5 – 31; col. 26 lines 43 – 49]; and

control information, which is provided to identify buffering state information of the markup document to be downloaded [col. 34 line 66 – col. 35 line 18].

21. Landsman fails to specifically state that buffering state information is identified by control information. However, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to include control information which is provided to identify buffering state information of the markup document to be preloaded because Landsman teaches that the advertisement can not be played until after it is cached [col. 26 lines 43 – 49], motivating one of ordinary skill in the art to provide a way to determine if it is cached. Furthermore, Silberschatz teaches outputting state information of a buffer [page 427 # 6 – 8].

22. It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to combine these teachings because Landsman teaches performing I/O in a computer system and Silberschatz teaches the details of servicing I/O requests.

23. As to claim 2, Landsman teaches the control information includes an API that generates a report signal used to identify a buffering state of the markup document [col. 34 line 66 – col. 35 line 18]. See the rejection of claim 1 for further explanation.

24. As to claim 3, Landsman teaches the control information includes an [obj].isCached(URL, resType) API that generates a report signal, where the URL is a parameter indicating a file path of the markup document and the resType is a parameter indicating an attribute of the markup document [col. 12 lines 15 – 38; col. 26 lines 43 – 49; col. 34 line 66 – col. 35 line 18]. See the rejection of claim 1 for further explanation.

25. As to claim 4, Landsman fails to specifically teach returning a value based on success, failure or incomplete loading. However, Silberschatz teaches returning values depending on the current state, including success, failure and incomplete [page 422 ¶ 3; page 427 # 6 – 8].

26. As to claim 5, Landsman teaches the control information includes an API that generates a fetch signal used to issue a command to preload the markup document [col. 34 line 66 – col. 35 line 18]. See the rejection of claim 1 for further explanation.

27. As to claim 6, Landsman teaches or at least implies that the API returns a response indicating whether the command to preload the markup document has been successfully transmitted using the fetch signal [col. 34 line 66 – col. 35 line 18]. Landsman teaches providing information and control over downloading, such as providing an indication that downloading is being performed or complete, which would indicate a request was successfully transmitted. This would be important because

Landsman teaches that advertisements can only play after being fully cached [col. 26 lines 43 – 49].

28. As to claim 7, Landsman teaches the control information includes an API that is used to determine whether preloading of the markup document is completed [col. 34 line 66 – col. 35 line 18]. See the rejection of claim 1 for further explanation.

Conclusion

29. The prior art made of record on the P.T.O. 892 that has not been relied upon is considered pertinent to applicant's disclosure. Careful consideration of the cited art is required prior to responding to this Office Action, see 37 C.F.R. 1.111(c).

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Price whose telephone number is (571) 272-4196. The examiner can normally be reached on 6:00am - 2:30pm, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Thomson can be reached on (571) 272-3718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NP

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER